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EXAMINER

LEO, L

ART UNIT	PAPER NUMBER
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3743

18

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UNITED STATES DEPARTMENT OF COMMERCE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 18

Application Number: 09/127,256

Filing Date: February 9, 2000

Appellant(s): Elkins, William

C. Michael Zimmerman
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed October 10, 2000.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief contains a statement identifying there are no related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

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(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1, 4, 5, 10, 13, 15-16, 18, 20 and 24 stand or fall together and claims 3, 5, 8-9, 12, 14, 17, 19 and 22-23 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

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(10) Grounds of Rejection

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6, 8-10, 12-20 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Prior Art Figure 2 in view of Haugeneder.

Applicant's Prior Art Figure 2 (pages 3-4) discloses a heat exchange panel to be conformed to a complex shape comprising:

first and second layers of a flexible material conformable to a complex shape;
a border seal sealing the first and second layers at the border 206;
a first port 222 and a second port 226;
the first and second layers being directly sealed together interiorly of said border at a multiplicity of points to form a dot matrix 210 of attachments organized into first 212 and second 213 imaginary lines for connecting dots to nearest dots, the first and second imaginary lines intersecting at 60 degrees;

but does not disclose first and second lines intersecting at an angle of 70 to 110 degrees.

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Haugeneder discloses a heat exchange panel comprising a first layer and second layer having a border seal; a first port 1 and second port 2; a plurality of dot matrix of attachments 3-6 arranged into first and second imaginary lines crossing at 90 degrees for the purpose of achieving a desired heat exchange by providing optimum flow resistance and flow (column 3, lines 43-50).

Since Applicant's Prior Art Figure 2 and Haugeneder are both from the same field of endeavor and/or analogous art, the purpose disclosed by Haugeneder would have been recognized in the pertinent art of Applicant's Prior Art Figure 2.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Applicant's Prior Art Figure 2 first and second imaginary lines crossing at 90 degrees for the purpose of achieving a desired heat exchange by providing optimum flow resistance and flow as recognized by Haugeneder.

Regarding claims 2, 7, 11 and 16, Haugeneder discloses the first and second lines intersect with the nominal direction of flow 8 at about 34 degrees (gleaned from Figure 1).

Regarding claims 3-5, 8-9, 12-14, 17-20 and 22-24, Applicant's Prior Art Figure 2 meets the claimed limitations.

Regarding claims 6-9, the method of manufacturing claims are believed met by the combination of Applicant's Prior Art Figure 2 and Haugeneder.

Regarding claims 10-14, the method of operating claims are believed met by the combination of Applicant's Prior Art Figure 2 and Haugeneder.

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Regarding claims 15-19, to employ the device of the combination of Applicant's Prior Art Figure 2 and Haugeneder in a well known system (e.g. Elkins et al.) requires only routine skill in the art.

(11) Response to Argument

In response to appellant's argument that Haugeneder is nonanalogous art, it has been held that a prior art reference must either be in the field of appellant endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Haugeneder is in the same field of endeavor. Appellant is reminded that the claimed instant invention is a "heat exchange panel," regardless of statements of intended use or disclosure. Haugeneder discloses a "heat exchange panel" comprising first and second layers with a border seal, and a multiplicity of points to form a dot matrix of attachments organized into first and second imaginary lines.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Haugeneder *teaches* to one of ordinary skill in the art to arrange a plurality of dot matrix of attachments into first and second

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imaginary lines crossing at 90 degrees for the purpose of achieving a desired heat exchange by providing optimum flow resistance and flow (column 3, lines 43-50).

In the combination, appellant's Prior Art Figure 2 is exactly the same as the instant invention as claimed, except the specific orientation of the imaginary lines. Whatever problem solved or features present in the instant invention as claimed are now inherently present in the Prior Art Figure 2 with the specific orientation of the imaginary lines to achieve optimal flow and heat exchange as taught by Haugeneder. The similar structure of the combination functions in a manner similar to the instant invention as claimed.

Regarding appellant's remarks with respect to the curvilinear ripple construction, the structure is inherently present in the combination. The ripple construction of Prior Art Figure 2 is more jagged due to the orientation of imaginary lines at 60 degrees. The teaching of Haugeneder is believed to provide a "curvilinear" or smooth ripple construction due to the orientation of imaginary lines at 90 degrees, since the cycle lengths would be shortened. As noted by appellant, hard corners provided by the trapezoidal or triangular are the problem, whereas the square shape now provided by the 90 degree teaching cures this problem.

The Examiner agrees the declaration is opinion evidence. Full consideration of Mr. Kast's "legal conclusion" of the nonobviousness of the combination of Applicant's Prior Art Figure 2 and Haugeneder has been made. "All of Mr. Kast's statements hinge on Haugeneder not disclosing or teaching features or structures, which are already disclosed by Applicant's Prior Art Figure 2." By this statement, the Examiner believes all structures and features are already present

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in Prior Art Figure 2. The only structure lacking is the orientation of imaginary lines which is clearly taught by Haugeneder for the purpose explicitly disclosed therein. By piece-mealing the references, one is unable to view the combination of references as a whole. Haugeneder is not concerned with "bulges" because that feature is not being taught. The orientation of imaginary lines is relied to be taught by Haugeneder.

From the very start, the Examiner has demonstrated the motivation to combine, "The secondary reference of Haugeneder teaches one of ordinary skill in the art to employ a plurality of dot matrix of attachments arranged into first and second imaginary lines crossing at 90 degrees for the purpose of achieving a desired heat exchange by providing optimum flow resistance and flow." Appellant chooses to ignore the combination of references and the clear motivation provided therein. The Examiner appreciates the problems faced by in appellant's invention. However, the combination of references meets the instant invention as claimed. Should the Office grant patents for two identical structured devices, even though the inventors were facing different problems? The answer is no. Similar structures function in similar manners, regardless of the design intention.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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PRIMARY EXAMINER
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January 2, 2001



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